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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,964	11/26/2001	Franz-Josef Rubroder	02481.1671-01	1450

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EXAMINER

CHERNYSHEV, OLGA N

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 07/11/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,964

Applicant(s)

RUBRODER ET AL.

Examiner

Olga N. Chernyshev

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Response to Amendment

1. Claims 23 and 48 have been amended and claims 78-84 have been added as requested in the amendment of Paper No. 13, filed on May 09, 2003. Claims 23-84 are pending in the instant application.

Claims 23-84 are under examination in the instant office action.

2. The Text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

4. Applicant's arguments filed on May 09, 2003 have been fully considered but they are not deemed to be persuasive for the reasons set forth below.

Claim Objections

5. Claim 78 is objected to because of the following informalities: claim 78 does not end with a period, see MPEP 608.01(m). Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. Claims 23-34, 40-64, 70-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hong Qi et al. for those reasons of record in sections 6 and 7 of Paper No. 11 and the reasons that follow.

Claims 23-34, 40-64, 70-77 as amended and new claim 78 are directed to a process for the storage of a protein in an aqueous solution comprising adding an amount of cysteine effective to delay the decrease of the effective concentration of the protein by preventing chemical modification of SH groups on the protein during storage. Applicant submits that the protein used by Hong Qi et al. "is a 31-amino acid peptide with no SH groups". [...] Thus, Qi does not teach or suggest preventing the modification of SH groups on a protein or the amount of cysteine as claimed" (page 8, last paragraph of the Response). These arguments have been fully considered but are not deemed persuasive for the following reasons.

Hong Qi et al. describe that addition of cysteine prolongs the stability of a protein, insulinotropin up to 100 days while stored at 5°C, thus meeting the limitations of original claims 23, 24, 33, 40-42, 48-54 and 63. It appears that amendment to the claims 23 and 48, which added additional limitation "by preventing chemical modification of SH groups on the protein", limits the scope of the claimed inventions to a process for the storage of only those proteins, which contain SH groups. However, as it is clearly shown by the reference of Hong Qi et al., addition of cysteine to a protein, which does not contain SH groups, also prolongs the stability of that protein. This is also supported by the well-established scientific and general knowledge in the art that proteins are subject to oxidation and that cysteine is the best-known biologically available non-toxic, temperature-resistant reducing agent, which is confirmed by its routine use for protection of proteins and oils from oxidation.

Moreover, the newly added limitation "by preventing chemical modification of SH groups on the protein" only discloses one of the mechanism by which the cysteine prevents the oxidation of a protein during the storage process. However, the discovery of an inherent property

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of a prior art process can not serve as a basis for patenting that process. See *Ex parte Novitski*, 26 USPQ2d 1389 (Bd. Pat. App. & Inter. 1993) (The Board rejected a claim directed to a method for protecting a plant from plant pathogenic nematodes by inoculating the plant with a nematode inhibiting strain of *P. cepacia*. A U.S. patent to Dart disclosed inoculation using *P. cepacia* type Wisconsin 526 bacteria for protecting the plant from fungal disease. Dart was silent as to nematode inhibition but the Board concluded that nematode inhibition was an inherent property of the bacteria. The Board noted that applicant had stated in the specification that Wisconsin 526 possesses an 18% nematode inhibition rating.).

Thus, at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to use cysteine as an additive antioxidant for protein storage. One skilled in the art would have been motivated to do this because of the general knowledge in the art that cysteine is a reducing agent and because the disclosure of Hong Qi et al. clearly provides support for such use.

New grounds of rejection necessitated by amendment

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 23-78 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. Claim 23 and 48, as amended, recite the limitation "SH groups on the protein" referring to "a protein in an aqueous solution". There is insufficient antecedent basis for this limitation in the claims.

9. Claims 24-47 and 49-78 are indefinite for being dependent from the indefinite claims.

Terminal Disclaimer

10. The terminal disclaimer filed on October 8, 2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent 6,339,061 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Conclusion

11. Claims 79-84 are allowed and claims 23-78 are rejected.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (703) 305-1003. The examiner can normally be reached on Monday to Friday 9 AM to 5 PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (703) 308-6564. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-0294 for After Final communications.

Certain papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax center located in Crystal Mall 1 (CM1). The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). NOTE: If Applicant *does* submit a paper by fax, the original signed copy should be retained by Applicant or Applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers.

Official papers filed by fax should be directed to (703) 308-4556 or (703) 308-4242. If either of these numbers is out of service, please call the Group receptionist for an alternative number. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. Official papers should NOT be faxed to (703) 308-0294.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Olga N. Chernyshev, Ph.D.
July 10, 2003

OC



JOHN ULM
PRIMARY EXAMINER
GROUP 1800